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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,495	08/18/2003	Kermit Roger Spalding		1842

7590 08/11/2004  
KERMIT ROGER SPALDING  
P.O. BOX 631364  
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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,495	SPALDING, KERMIT ROGER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Naschica S Morrison	3632	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input checked="" type="checkbox"/> Other: <u>PROSE GUIDE</u>            |

### **DETAILED ACTION**

This is the first Office Action for serial number 10/642,495, The Chelsea Swing Arm System Assembly, filed on August 18, 2003. Claim 1 is pending.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 1, line 16 "sidecar" should be --side car--; on page 2, line 8, delete "axle" before "swing arm"; on page 4, delete the sections entitled "CLAIM" and "ABSTRACT OF THE DISCLOSURE"; on page 5, line 9 "sidecar" should be --side car--; in the Abstract, delete the paragraph beginning "Prior to me inventing"; on lines 13 and 19 "sidecar" should be --side car--; on line 24, delete the sentence beginning "It was to these ends"; and the last two paragraphs should be merged to form one paragraph. Appropriate correction is required.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

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Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: On line 1, delete "I claim that my invention is" and "a" should be --A--; on line 3, "sidecar" should be --side car-- and "a existing" should be --an existing--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,078,815 to Vetter. Vetter discloses a swing arm system assembly (92) that allows for the fitment of a motorcycle type wheel (at 38 in Fig. 1 generally) to be retrofitted to any motorcycle side car chassis with an existing swing arm chassis design that utilizes a 13-inch diameter or less lug type trailer wheel.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 3948335 to Vetter; 4385770 to Mitchell; 4477097 to Hayes; 4580652 to Turner et al; 4715477 to Suzuki; 5238258 to Michaud

The above references disclose side car assemblies relevant to the present invention.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The

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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.

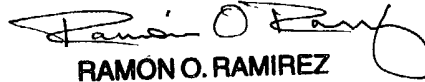


*Naschica S. Morrison*

Patent Examiner

Art Unit 3632

8/6/04



**RAMÓN O. RAMÍREZ**  
PRIMARY EXAMINER

**Mini Lecture**

***Information to Pro Se Inventors  
Regarding responses to Office Actions***

**INTRODUCTION**

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent.

37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

**DISCUSSION**

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

**I. Response by Applicant**

The applicant **MUST** respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings, and/or claims to overcome the rejection or

objection. Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. **The response must be signed by ALL applicants.** 37 C.F.R. § 1.33. The response must be identified by the Serial Number of the Application, the Art Unit, and the name of the examiner. An example follows:

Appl. No: XX/YYY,YYY  
Applicant: James Q. Inventor  
Filed : April 19, 2003  
Title : Bucket with Handle  
Art Unit: 3632  
Examiner: John Doe

#### *A. Arguments*

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. *Id.*

#### *B. Amendments to the Specification*

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be made by replacement of the entire paragraph/section. Additions to the specification should be underlined. Any deletions from the specification should be ~~stricken~~ through. Applicants must provide a marked-up version of the same paragraph or section showing changes. Clear instructions must be provided for the location of the amendment entry (e.g., paragraph number, page/line number). Deletion/Addition of an entire paragraph only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121.



It is not necessary to submit a new specification unless one has been required by the Examiner.

*An amendment to the specification should appear as follows:*

Please replace paragraph beginning at page 5, line 15, with the following rewritten paragraph:

-- In the construction of the bucket of this invention, various materials have been selected and which offer a number of diverse properties and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable ~~polymer~~ plastic material. Where an aesthetic appeal is desired, the bucket can be any of one of many attractive colors. The following listing of properties serves to define possible uses for the buckets. --

#### *C. Amendments to the Claims*

An amendment to the claim may remove a rejection or objection. *Any amendment to the claims must be made by replacement of the entire claim and the provision of a new copy of all remaining claims.* Applicants must provide a marked-up version of the same claim showing changes. Additions to the claim should be underlined. Any deletions from the claims should be shown with a line striking through the deletions, i.e., ~~four~~ legs. Deletion/Addition of an entire claim only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121. Parenthetical information is to be provided after each claim number to indicate how many times the claim has been amended (e.g., "(Once Amended)", "(Twice Amended)", etc ...) or that the claim is an "original" claim. If a claim has been cancelled, then the claim number should be provided with the word cancelled written beside it. 37 C.F.R. § 1.119.

For example, if a claim to a chair was originally written:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

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1. (Once Amended) A chair comprising a horizontal seat, a vertical back, and ~~a plurality of four vertical support members~~ legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

The listing of claims will replace all prior versions, and listings, of claims in the application. An example follows:

**Listing of Claims:**

Claims 1-4 (canceled)

Claim 5 (original): A bucket with a black handle.

Claim 6 (original): A bucket of claim 5 wherein the handle is metal.

Claim 7 (withdrawn)

Claim 8 (currently amended): A bucket made of ~~yellow~~ green plastic.

Claim 9 (previously amended): A bucket of aluminum-coated galvanized metal.

Claim 10 (previously added): A bucket having a circumferential upper lip.

Claim 11 (new): A plastic bucket having a blue handle.

*D. Drawing Corrections*

Finally, correction of the drawings may remove a rejection or objection. Changes to the drawings are submitted as proposed drawing corrections and can be made only with permission of the Office. 37 C.F.R. § 1.123. Proposed drawing corrections should be filed with the response, but should be a separate paper. M.P.E.P. § 608.02(r). The proposed corrections should appear in *red ink* in the drawings. M.P.E.P. § 608.02(v).

## **II. New Matter**

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

See M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

## **III. Period For Response**

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-326) of the Office action. Usually, a 3 month shortened statutory period is set. M.P.E.P. § 710.02(b). The applicant's response must be received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. §

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1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

Months Past Response Date	Fee Due (Small / Large Entity)
Response within Time Allowed	None / None
1 Month	\$55 / \$110
2 Month	\$210 / \$420
3 Month	\$475 / \$950
4 Month	\$740 / \$1,480
5 Month	\$1005 / \$2,010

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135.

Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$210.00 (for a small entity; \$420.00 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing

date of an Office action. The Office action sets a **2 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$740 (for a small entity; \$1,480 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an

Office action. The Office action sets a **3 month** shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

#### **IV. Certificate of Mailing**

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. See 37 C.F.R. § 1.8. This "Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-450" on (Date of Deposit).

(Name of applicant, assignee, or Registered Representative)

(Signature)

(Date)

This "Certificate" may appear anywhere on the page, and may be handwritten or typed. *Id.* It MUST be signed by the person who actually deposits the paper with the Postal Service, and the date MUST be the actual date on which it is mailed. *Id.*

For the purpose of calculating extensions of time, the date shown on the certificate will be used as the date on which the paper was received by the Office, regardless of the date the Postal Service actually delivers the response. In this way, postal delays would not affect the extension-of-time fee.

Furthermore, Applicant is encourage to include with the response a self addressed and stamped postcard completely itemizing the papers submitted with applicant's response. See M.P.E.P. § 503. When the response is received by the Office, the postcard is date-stamped and returned to the applicant. *Id.* This is an applicant's best indication of the date the Office received the response and if all of the papers submitted have been received.

### **CONCLUSION AND CAVEAT**

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. See 37 C.F.R. § 1.111; M.P.E.P. § 714.02.